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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,450

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Eiji Kubota

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EXAMINER

DULANEY, BENJAMIN O

ART UNIT

PAPER NUMBER

2625

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/668,450	<b>Applicant(s)</b> KUBOTA, EIJI	
	<b>Examiner</b> BENJAMIN O. DULANEY	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 7-14 is/are rejected.
- 7) ☒ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1) Claims 5 and 6 recites the limitation "said x-direction or said y-direction" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5<sup>th</sup> ed. 1993).) "Non functional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32USPQ2d1031, 1035 (Fed Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 17660 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's

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functionality to be realized, and is thus statutory See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

2) Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 14 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e. “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” -Guidelines Annex IV). That is the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim “a computer-readable recording medium that records a program” or equivalent in order to make the claim statutory. Any amendment to the claim should commensurate with its corresponding disclosure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3) Claims 1-3, 5 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,927,208 by Hagstrom et al.

4) Regarding claims 1, 10, 13 and 14, Hagstrom teaches a print controller for determining an amount of misalignment of print position on directly printing on a label surface of an electronic information recording medium, said print controller comprising: a marker print unit for controlling a printing apparatus to print a marker at a predetermined position of an adjustment medium on which a base line is previously printed to determine said amount of misalignment and which has a shape identical to said electronic information recording medium (column 4, lines 13-67); an input unit for inputting from a user at least two portion specifying information for specifying portions where said base line and said marker have a predetermined positional relationship (column 5, line 18); and a misalignment amount determination unit for determining said amount of misalignment based on the positional relationship between an absolute position at which said base line should be located and the portions specified by said portion specifying information (column 5, lines 19-29).

5) Regarding claim 2, Hagstrom teaches a print controller according to claim 1, wherein one of said base line and said marker includes a circle (figure 4), and the other includes scale marks printed at predetermined intervals on at least two axes that are directed from the center of said adjustment medium to the circumference of said circle and differ in direction (figure 4).

6) Regarding claim 3, Hagstrom teaches a print controller according to claim 2, wherein said axes include two axes directed from the center of said adjustment medium

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to a x-direction and a y-direction that are reference directions for determining said amount of misalignment (figure 4, item 79 and 86).

7) Regarding claim 5, Hagstrom teaches a print controller according to claim 2, wherein when the direction of said determined amount of misalignment is not identical to said x-direction or said y-direction that is a reference direction for determining said amount of misalignment, said misalignment amount determination unit resolves said amount of misalignment into its x-component and y-component to determine said x-component and said y-component (figure 4; column 5, lines 15-17 and 21-29).

8) Regarding claim 7, Hagstrom teaches a print controller according to claim 1, wherein said input unit inputs portion specifying information related to portions at which said base line overlaps with said marker (column 5, line 18).

9) Regarding claim 8, Hagstrom teaches a print controller according to claim 1, said print controller further comprising: a print data generation unit for generating print data that reflects the amount of misalignment determined by said misalignment amount determination unit and is then output to said printing apparatus (column 4, lines 13-67).

10) Regarding claims 9 and 12, Hagstrom teaches A printing apparatus, said printing apparatus comprising: a misalignment amount input unit for inputting an amount of misalignment determined by said print controller according to claim 1; a print data input unit for inputting print data to be printed; and a print unit for correcting a print position of said print data based on said amount of misalignment and then printing (Column 3, lines 54-58).

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11) Regarding claim 11, Hagstrom teaches a print controller according to claim 10, wherein at least one of said base line and said marker is provided with scale marks for specifying said positional relationship, and said positional relationship specifying information is specified based on said scale marks (figure 4).

### ***Allowable Subject Matter***

Claims 4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 4 and 6, the prior art does not contain a valid combination of references that teaches reference marks on an axis directed to a direction other than the X and Y directions, where the axis intersects the X and Y axis at a predetermined angle.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN O. DULANEY whose telephone number is (571)272-2874. The examiner can normally be reached on Monday - Friday (10am - 6pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/  
Examiner, Art Unit 2625

/Twyler L. Haskins/  
Supervisory Patent Examiner, Art Unit 2625